



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,744	02/25/2004	James Duncan	75791.0240	2997

5073 7590 01/25/2006

BAKER BOTTS L.L.P.  
2001 ROSS AVENUE  
SUITE 600  
DALLAS, TX 75201-2980

EXAMINER

PENG, CHARLIE YU

ART UNIT PAPER NUMBER

2883

DATE MAILED: 01/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/786,744

Applicant(s)

DUNCAN, JAMES

Examiner

Charlie Y. Peng

Art Unit

2883

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-30 is/are pending in the application.  
4a) Of the above claim(s) 1-9, 18 and 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-17, 20 and 21 is/are rejected.
- 7) ☒ Claim(s) 22-30 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 02/25/04, 07/22/04
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

Applicant's election without traverse of Species B, claims 10-17 and 20-30 in the reply filed on 21 October 2005 is acknowledged.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11-16, 20, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. PGPub 2004/0105239 to Chiang in view of U.S PGPub 2003/0076658 to Aronson et al. Chiang teaches an optical transceiver module having a housing 200 on a first end and a first connection port 230 on a second end of the module,

the second end having a first dimension (exterior dimension of the connection port 230) and an initial second dimension (actual interior/port dimension of the connection port 230,

the first connection port (receptacle) 230 can be converted to a second connection port (receptacle) 310 of a converted second dimension by attaching a connection element 400,

wherein the connection element 400 can be seen to have two adapters 430 coupling onto the second end of the transceiver module and secures the connection

port 310 in place by two connection means. (See at least Fig. 1 and description)

Although Chiang is silent with regard to placing the transceiver module in a front panel opening of a network device, this is commonly practiced in the art. Aronson teaches placing a plurality of transceiver in openings of a bezel 20 (panel) to connect a host interface to a fiber optical network. (See at least Fig. 1 and [0002]) It would have been obvious to one of ordinary skill in the art at the time the invention was made to place the transceiver of Chiang in a in an opening of a panel. The motivation would be that this technique can be used to secure and organize multiple transceivers in a small space.

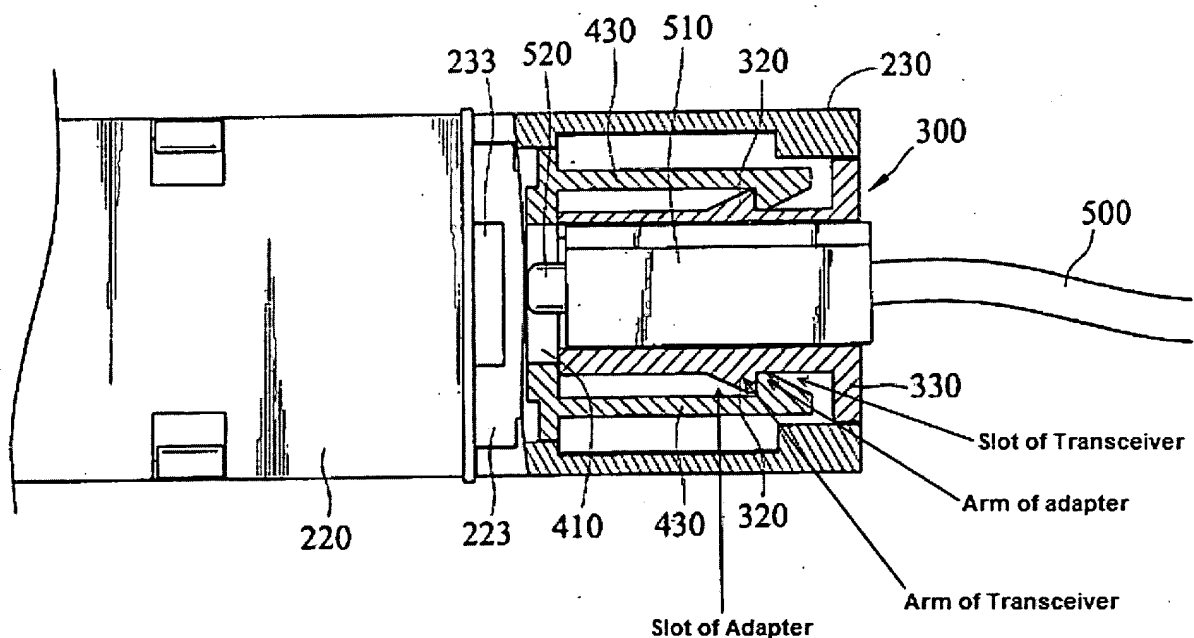


FIG. 3

With specific reference to claims 11-13 and 15, Chiang teaches that the adapters are identical and placed on opposite of the transceiver, and that the connection means of the adapters 430 has trapezoid-shaped protrusions (hereby defined as an arm) on

the surfaces of the adapters 430, and that the protrusions fit within slots on the transceiver. Similarly, the transceiver has protrusions/arms that fit within slots on the adapters. (See Fig. 3)

With specific reference to claim 14, securing two separate and relatively moveable parts using adhesive is a well-known practice in many arts, and it would have been obvious to one of ordinary skill in the art to do so. The motivation would be to permanently attach the adapter and the transceiver module as well as increase the coupling strength so the two parties are less likely to break apart.

With specific reference to claim 16, it has been held that the recitation that an element is capable of, adapted to, or can perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138. Furthermore, Aronson clearly teaches transceivers of all sizes can be coupled to an opening of a panel.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chiang and Aronson et al. further in view of U.S. PGPub 2003/0021552 to Mitchell. Chiang and Aronson teach the transceiver module with the adapters as previously stated except for additional collars that can be removably coupled to the second end of the transceiver module. Mitchell an optical transceiver module 10 that can be coupled to two collar-like shields 14 18, wherein the selection of the shields 14 18 depends upon whether a size/function converting sleeve 16 is placed on an end of the transceiver module. The shields have leaf springs 30 32. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the shields with leaf springs. The

motivation would be that the leaf springs of the shields can engage with the panel 22 and spot the transceiver module from moving relative to openings 24 26 on the panel 22.

***Allowable Subject Matter***

Claim 22 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Firstly, Chiang and Aronson teach the transceiver module with the adapters as previously stated, but the transceiver module has an insert to reduce the interior dimension of the second end of the transceiver module while the first (exterior) dimension remains the same. The applicant claims a scenario wherein the exterior dimension of the receptacle changes in order to be adapted to an opening on a panel. The transceiver module by Chiang and Aronson thus functions fundamentally different from that disclosed in claim 22, and any modification to meet the claimed structure would destroy the transceiver module taught by Chiang and Aronson. Secondly, Mitchell teaches a fitting sleeve 16 used to resize the exterior dimension of an end of a transceiver module, but the sleeve is a one-piece design, lacking two adapters as claimed and subsequently cannot render obvious structures of the adapters and the transceiver module, i.e., it does not teach or suggest that “the transceiver receptacle has a first side defining a first interface portion and a second side defining a second interface portion, wherein the first adapter has a first connection portion configured to couple with the first interface portion, wherein the second adapter has a second connection portion configured to couple with the second

interface portion". It is the examiner's opinion that the prior art of record, taken alone or in combination, fails to disclose or render obvious limitations as recited in claim 22 in combination with the rest of the limitations of the base.

Claims 23-30 are objected to but allowable as dependent claims of claim 22.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Please see PTO-892 for additional references cited.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charlie Y. Peng whose telephone number is (571) 272-2177. The examiner can normally be reached on 9 am - 6 pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frank Font can be reached on (571) 272-2415. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Charlie Peng  
January 4, 2006



**Brian Healy**  
**Primary Examiner**